

Attorney Docket No. P11303

REMARKS/ARGUMENTS**1. Claim Status:**

Claim 1 has been amended.

Claim 41 has been added.

Claims 1-41 are pending.

2. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 1-25, 28, 30 and 33-40 under 35 U.S.C. § 103 (a) as being unpatentable over Byrne (US 5,737,703) and further in view of Lintulampi (US 6,377,804). The Examiner rejected claim 29 under 35 U.S.C. § 103 (a) as being unpatentable over Byrne (US 5,737,703) in view of Lintulampi (US 6,377,804) and in further view of Naghshineh, M. et al. (End-to-end QoSprovisioning in Multimedia Wireless Mobile Networks Using an Adaptive Framework, November 1997, IEEE Communications Magazine, pp. 72-81). The Examiner rejected claims 26-27, 31-32 under 35 U.S.C. § 103 (a) as being unpatentable over Byrne (US 5,737,703) in view of Lintulampi (US 6,377,804) and in further view of Acampora et al. (US 5,497,504). The Applicant respectfully traverses this rejection for the following reasons:

a. Not All Elements are Taught by the Combination:**Claims 1, 15, and 40**

The Applicant notes that each of the claims 1, 15 and 40 contain an element or step for "selecting, in the case of that the handover is necessary, which communication or communications are handed over."

For instance, claim 1 states:

1. A communication system comprising:
 - a Universal Mobile Telecommunications System (UMTS) wherein the UMTS network is capable of handling a first number of communications between a mobile user equipment,

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a Global System for a Mobile Communication System (GSM) networks, wherein the GSM network is capable of handling a second number of communications between the mobile user equipment and the GSM network, and wherein at least one of the mobile user equipment and the communication system contain

at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated and

at least one means for selecting, in the case that the handover is necessary, which communication or communications are handed over,
and

at least one means for executing the at least one decision.

The Applicant respectfully submits that neither Byrne nor Lintulampi describe selecting element as claimed in claim 1.

In paragraph 1 of the Office Action, dated June 5, 2003, the Examiner stated "the Applicant's arguments with respect to claims 1, 15, and 39 have been considered, but are moot in previous rejection." In paragraph 2, the Office Action states:

The examiner disagrees because the modified Byrne discloses "the cellular cordless telephone continuously monitors for radio system availability, and automatically selects and reselects radio systems, there exists the possibility of a new or different radio system" (see Byrne, col. 6, lines 26-35), and the examiner interprets "radio system" corresponds to "communication." (emphasis added).

The Applicant respectfully disagrees with the Examiner's interpretation of the term "communication."

As is well known in the art, a "radio system" is simply not the same as a "communication." Additionally, the term "communication" is partially defined in the Applicant's specification on page 2, lines 20-23, as:

Future communication systems will allow mobile user equipments to perform a greater number of communications simultaneously. Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer).

Thus, there is no doubt that the term "communication" is not the same element as the term "radio system." The claims, therefore, do not recite a means for monitoring radio system availability, and a means for selecting radio systems as discussed in

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Byrne. In contrast, each of the independent claims 1, 15, and 40 contain an element or step for "selecting, in the case of that the handover is necessary, which communication or communications are handed over."

Patent law allows the inventor to be his own lexicographer. . . . [T]he specification aids in ascertaining the scope and meaning of the language employed in the claims inasmuch as words must be used in the same way in both the claims and the specification. *United States v. Teletronics, Inc.*, 8 USPQ 2d 1217, 1220 (Fed. Cir. 1988), cert. denied, 490 U.S. 1046 (1989). The Examiner cannot simply redefine a term and force his own definition upon the Applicant to support a rejection - especially when the term has been previously defined in the Applicant's specification.

In the Advisory Action, dated September 10, 2003, the Examiner stated:

Byrne teaches "substantially simultaneously communicate with respective radio systems during said handover of a call from the first radio system to the second radio system for communicating with said respective radio systems." (see col. 3 lines 56-60).

The entire sentence cited by the Examiner from Byrne is reproduced below:

In a preferred embodiment the first and second of the communication means are responsive to the control means to substantially simultaneously communicate with respective radio systems during said handover of a call from the first radio system to a second radio system for communicating with said radio systems substantially simultaneously communicate during said handover of a call from the first radio system to the second radio system. (Byrne, col. 3, lines 57-64)

It appears that the above quotation is simply describing any handover procedure where a call (in other words, a single call) simultaneously communicated from a first radio system to another.

The Applicant is at a loss to understand how the above quotation from Byrne can be read upon at least one means for selecting which communication or communications are handed over. According to Byrne's terminology, the term "call" is the term that most closely can be related to the term "communication" as used in claim 1.¹ A reading of

¹ Although the term "communication" as used in the claims is not to be equated to the term "call" as used by Byrne. As partially defined in the Specification: "Future communication systems will allow mobile user equipments to perform a greater number of communications simultaneously. Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer)."

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Byrne indicates that Byrne does not teach a means for selecting which calls are handed over. In Byrne the single call is just handed over, but there is nothing indicating that a "call" selection is made.

In order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. As shown above, Byrne does not disclose an element for "selecting, in the case of that the handover is necessary, which communication or communications are handed over." Additionally, Lintulampi, does not make up for the shortcomings of Byrne because it also does not show the missing elements of base claims 1, 15 and 40. Thus, allowance of claims 1, 15 and 40 is respectfully requested.

Claim 39

With respect to claim 39, the Applicant previously argued that Byrne does not describe maintaining a communication on hold during and after an intersystem handover.

In response, in the Office Action, the Examiner stated:

With argument respect to claim 39, Byrne discloses in the abstract "Communication with respective radio telephone system may be simultaneously continued during handover until the handover is complete", which reads on "a call being place on hold or the handover of a call placed on hold" with broadest reasonable interpretation."

Paragraph 2, Office Action dated June 5, 2003.

This argument was maintained in the Advisory Action, which states:

And, with argument respect to claim 39, Byrne discloses in the abstract "Communication with respective radio telephone system may be simultaneously continued during handover until the handover is complete." which reads on "a call being place on hold or the handover of a call placed on hold."

The Applicant respectfully disagrees with the Examiner's interpretation of the cited passage. A more complete excerpt from the Abstract of Byrne is reproduced below:

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Communication with respective radio telephone systems may be simultaneously continued during handover until the handover is complete or the communication with one radio telephone system ceases before communication with the other radio telephone system commences. Delays between signals of different radio telephone systems which would cause audible interference are inhibited by FIR filtering and/or dynamic time-warping.

The Applicant again notes that the cited passage says absolutely nothing about placing a communication on hold. The passage merely states that transmission of communication or call data will continue during a handover. In fact, the "continuing communication" as described above inhibits delays that could cause audible interference. Thus, in Byrne, call data (e.g., voice data) continues to be sent throughout the handover procedure. This is in sharp contrast to the claimed elements of "holding at least one of the communications" and "maintaining said at least one of the communications on hold during and after the intersystem handover" - where the sending of communication or call data is stopped.

There is little doubt as to the meaning of the claimed elements. As indicated in the Applicant's specification on page 45, lines 9 through 16:

The core network CN sends a hold order HO to the mobile user equipment MUE. The hold execution element HE puts the requested call on hold and sends a message for hold acceptance HOA to the core network.

Thus, it is clear that the claimed elements of "holding at least one of the communications" and "maintaining said at least one of the communications on hold during and after the intersystem handover" are not the continued communications as described in Byrne. The claimed elements are simply not discussed in Byrne.

As discussed previously, in order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. As shown above, Byrne does not disclose an element for "holding at least one of the communications" and "maintaining said at least one of the communications on hold during and after the intersystem handover." Additionally, Lintulampi, does not make up

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for the shortcomings of Byrne because it also does not show the missing elements of claim 39. Thus, allowance of claim 39 is respectfully requested.

b. The recognition of a problem is not obvious even though the solution to the problem may be obvious:

Assuming *arguendo*, that the claimed invention is obvious remedy. In the present case, it is apparent from a reading of the Byrne patent and the Lintulampi patent that neither patent recognized the problem of having a communication system with a first access system and a second access system, wherein at least one of the access systems allows the mobile user equipment to perform more than one communication, wherein a intersystem handover of communication between the first access system and the second access system is possible. Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant and is part of the "subject matter as a whole" language of 35 USC §103. As the MPEP states in Section 2141.02:

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969).

For instance, Byrne appears focused on whether a single call may be simultaneously continued during handover until the handover is complete. In Lintulampi, a method of operating a mobile telephone with a geographic area having overlapping coverage from a first GSM network and a second UMTS network. Thus, neither solution recognizes the underlying problem of allowing the mobile user equipment to perform more than one communication² or session, wherein an intersystem handover of communication between the first access system and the second access system is possible.

² Again, the Applicant emphasizes that the term "communication" has been partially defined in the Specification to be: "Future communication systems will allow mobile user equipments to perform a greater number of communications simultaneously. Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer)."

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Thus, the solution to a problem in the independent claims, if they are obvious, are only obvious only after recognition of the problem by the applicant, and cannot be summarily rejected under 103.

c. The Combination of References is Improper:

Even if none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Byrne and Lintulampi patents cannot be applied to reject claims under 35 U.S.C. § 103.

Section 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed "as a whole".

Here, neither Byrne nor Lintulampi teaches, or even suggests, the desirability of the combination "a Universal Mobile Telecommunications System (UMTS) wherein the UMTS network is capable of handling a first number of communications between a mobile user equipment, a Global System for a Mobile Communication System (GSM) networks, wherein the GSM network is capable of handling a second number of communications between the mobile user equipment and the GSM network, and wherein at least one of the mobile user equipment and the communication system contain at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated and at least one means for selecting, in the case that the handover is necessary, which communication or communications are handed over, and at least one means for executing the at least one decision."

As the Federal Circuit has explained:

Most if not all inventions arise from a combination of old elements . . . Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed

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invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. In *re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000).

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In other words, the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Here, no such evidence has been presented. In addition, there is absolutely no teaching, suggestion or motivation to support the combination of Byrne and Lintulampi.

The current case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *In re Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way Byrne and Lintulampi could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint. Therefore, the combination of references is improper.

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In the present case it is clear that the combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

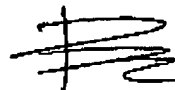
Independent claims 15, 39, 40 and 41 have similar elements to claim 1 and are thus allowable for the same reasons that claim 1 is allowable. The other claims 2-14, and 16-38 depend from claims 1 and 15 and recite further limitations in combination with the novel elements of these claims. Therefore, the allowance of the dependent claims is also respectfully requested.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview with the Examiner if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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